

### REMARKS

1. After entry of this paper, claims 1-9 and 11-33 are pending in the application. Reconsideration of this application is respectfully requested.
2. It is noted that non-elected claims 18-33 stand withdrawn from consideration.
3. The drawings stand objected to under 37 CFR 1.83(a) because they fail to show embodiment 120 in Figure 8, as described in the specification. The drawings also stand objected to because reference character "12" in Figure 8 is not described in the specification.

The objections are respectfully traversed as there is no embodiment 120 described in the specification. The specification describes a first embodiment of a kit, shown in Figure 8, that comprises a tube 120 (erroneously labeled by reference character 12) containing one or more reagents 140 and metal nanoparticles 160. See, for example, paragraph [0072] of the specification.

In order to correct the improper labeling of tube 120 in Figure 8 of the drawings, submitted herewith is a replacement sheet of Figure 8 which changes reference character "12" to --120 --.

Accordingly, withdrawal of this objection is respectfully requested.

4. Claim 16 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it is unclear to the Examiner what is meant by a nanoparticle-like texture.

To clarify the subject matter recited in claim 16, "nanoparticle-like texture" has been deleted and replaced with -- roughness that mimics the size and shape of a nanoparticle -- . Support for this amendment can be found, for example, in paragraph [0052] of the specification.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Claims 1-12 and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/59234 to Carron et al. (Carron).

Claim 1 has been amended to recite,

... providing a metal surface having at least one of a size and a shape that increases surface enhanced Raman scattering;

exposing the metal surface to a fluid suspected of containing the at least one of a chemical and a related species, the at least one of the chemical and the related species adsorbing to the metal surface if present in the fluid;

exciting the ~~fluid-exposed~~ metal surface with light to cause the ~~fluid-exposed~~ metal surface to produce the surface enhanced Raman scattering . . . .

The amendment limiting the surface to metal was originally recited in claim 10 (canceled herein). Support for the other amendments in claim 1 can be found, for example, in paragraph [0045] of the specification.

It is respectfully submitted that Carron fails to describe, teach or suggest the subject matter now recited in claim 1.

Specifically, Carron fails to anticipate claim 1 because Carron describes a metal surface with a chemical coating disposed thereon for chemically binding the analyte to the metal surface. Carron does not describe, teach or suggest “. . . the at least one of the chemical and the related species adsorbing to the metal surface if present in the fluid . . . ,” as currently recited in claim 1. For at least this reason, claim 1 and claims 2-12 and 17 dependent thereon, are allowable over Carron.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

6. Claims 13-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Carron as applied to claim 1, further in view of Sulk.

It is respectfully submitted that Carron in view of Sulk fail to describe, teach or suggest the subject matter now recited in claims 13-16. Specifically, claims 13-16 each call for “. . . the at least one of the chemical and the related species adsorbing to the metal surface if present in the fluid . . . ,” which is not described, taught, or suggested by Carron.

Sulk fails to cure the deficiencies of Carron, as Sulk describes a reactive coating including a tethering agent. After the reactive coating has reacted with an analyte, the tethering agent in the reactive coating tethers the reactive coating to silver particles. Thus, Carron in view of Sulk do not describe, teach or suggest the method recited in claims 13-16. For at least this reason, claims 13-16 are allowable over Carron in view of Sulk.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

7. Claims 13, 14, and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Carron as applied to claim 1, further in view of U.S. Patent Publication 20040135997 to Chan et al. (Chan).

It is respectfully submitted that Carron in view of Chan fail to describe, teach or suggest the subject matter now recited in claims 13, 14, and 16. Specifically, claims 13, 14, and 16 each call for "... the at least one of the chemical and the related species adsorbing to the metal surface if present in the fluid ...," which is not described, taught, or suggested by Carron.

Chan fails to cure the deficiencies of Carron, as Chan does not describe, teach or suggest "... the at least one of the chemical and the related species adsorbing to the metal surface if present in the fluid ...," not described, taught, or suggested by Carron. For at least this reason, claims 13, 14, and 16 are allowable over Carron in view of Sulk.

Further, claim 14 has been amended to call for the at least one nanoparticle to be provided in a colloidal solution form or a solution form. Support for this amendment can be found, for example, in paragraph [0059] of the specification. In contrast, Chan describes immobilized metal colloids. Thus, Carron in view of Chan also fail to describe, teach or suggest the subject matter added by claim 14.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

8. The Director is authorized to charge the fee for the three (3) month extension of time to Deposit Account No. 04-1679. The Director is also authorized to charge any payment required under 37 CFR 1.16 and any patent application processing fee under 37 CFR 1.17, associated with this paper, or credit any overpayment to Deposit Account No. 04-1679.

Respectfully submitted,

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